

Attorney Docket No.: LASP:129US  
Appl. No. 10/604,636  
Amdt. dated September 19, 2005  
Reply to Office Action of June 17, 2005

## Remarks

### Amendments to the Specification

In the specification, the Title of the Invention has been amended to correct a minor punctuation informality.

### The Rejection of Claim 8 Under 35 U.S.C. § 102(e)

Claim 8 was rejected under 35 U.S.C. § 102(e) as being anticipated by United States Patent Application Publication No. 2002/0104961 (*Hoffman et al.*). Applicants respectfully traverse this rejection and request reconsideration for the following reasons.

Applicants courteously submit that amended Claim 8 sets forth a limitation not contained in the teachings of *Hoffman et al.*, i.e., a displaceable deflection unit. Applicants respectfully assert that Examiner has acknowledged the deficiency of *Hoffman et al.* regarding a displaceable deflection unit. (Official Action dated June 17, 2005, Page 3, third paragraph). Thus, in view of the amendments to Claim 8, *Hoffman et al.* do not anticipate Claim 8 and all claims dependant therefrom.

Furthermore, *Hoffman et al.* do not disclose, teach, or suggest using a displaceable deflection unit. Hence, Applicants' Claim 8 and all claims dependant therefrom are also non-obvious in view of *Hoffman et al.*.

In view of the foregoing remarks, reconsideration and withdrawal of the rejections as being anticipated by *Hoffman et al.* are courteously requested.

### The Rejection of Claims 1-7, 9, 10, 13 and 14 Under 35 U.S.C. § 103(a)

Claims 1-7, 9, 10, 13 and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Hoffman et al.* in view of United States Patent No. 6,356,088 (*Simon et al.*). Applicants respectfully traverse this rejection and request reconsideration for the following reasons.

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This ground of rejection cannot stand because *Hoffman et al.*, and the captioned subject invention are commonly owned. *Hoffman et al.* and the instant application are both assigned to Leica Microsystems Heidelberg GmbH, Mannheim, Germany, and thus are commonly owned.

Under the present circumstances the rule that should apply is cited as: ¶ 7.21.02 *Rejection, 35 U.S.C. 103(a), Common Assignee or at Least One Common Inventor*, appearing on Page 700-59 of the MPEP, cited below:

¶ 7.21.02 Rejection, 35 U.S.C. 103(a), Common Assignee or at Least One Common Inventor

“Claim [1] rejected under 35 U.S.C. 103(a) as being obvious over [2].

The applied reference has a common [3] with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitute prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome either by: (1) a showing under 37 C.F.R. 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention “by another”; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 C.F.R. 1.131; or (3) an oath or declaration under 37 C.F.R. 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 C.F.R. 1.321(c). *For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(l)(1) and § 706.02(l)(2). [4]*” (emphasis added)

**Statement of Common Ownership**

**The captioned Application (Application Serial No. 10/604,636, filed August 6, 2003) and the reference, United States Patent Application Publication No. 2002/0104961 were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person.**

Effective November 29, 1999, subject matter which was prior art under 35 U.S.C. 103 via 35 U.S.C. 102(e) is now disqualified as prior art against the claimed invention because the subject matter of the *Hoffman et al.* publication and the claimed invention were, at the time the invention was made, owned by the same person, namely Leica Microsystems Heidelberg GmbH, Mannheim, Germany.

Accordingly, the basis for the rejection of the claims for reasons of obviousness that includes the citation of *Hoffman et al.* cannot stand because this citation has been effectively removed as a reference.

However, even if *Hoffman et al.* was not removed as a reference, the rejection cannot stand for the following reason, *Simon et al.* do not teach a displaceable deflection unit for setting a path length difference between the light of a first and second laser, they teach displaceable optics, *i.e.*, lenses, used to adjust and/or change the beam focus within the specimen. Additionally, *Simon et al.*'s disclosure contains a reference number error, more specifically reference number 38 has been used to identify both beam deflecting elements and focusing optics. Focusing optics 38, depicted in Figures 2 and 3, are shown to be displaceable by the placement of a bi-directional arrow proximate focusing optics 38. Contrarily, in Figure 4, beam deflectors 38 are shown without such a bi-directional arrow, thereby implying a fixed position for deflectors 38. Similarly, the specification is silent on the displaceability of beam deflectors 38. In support of this inference, please refer to collimator 40, which is shown proximate a bi-directional arrow, and described in the specification as "a displaceable collimator." (*Simon et al.*, Col. 5, Lines 49-50)

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Thus, as independent Claims 1 and 8 contain an element that is not disclosed in the cited references, *i.e.*, a displaceable deflection unit, it follows that Claims 1 and 8 are patentable over *Hoffman et al.* in view of *Simon et al.*. Additionally, dependent Claims 2-7 contain all of the limitations of independent Claim 1, due to their dependency therefrom. Similarly, dependent Claims 9, 10, 13 and 14 contain all of the limitations of independent Claim 8, due to their dependency therefrom. Therefore, since Claim 1 is non-obvious in view of *Hoffman et al.*, and further in view of *Simon et al.*, due to the missing element, it necessarily follows that Claims 2-7 are also non-obvious in view of *Hoffman et al.*, and further in view of *Simon et al.*, due to their dependency from Claim 1. Similarly, Claim 8 is non-obvious in view of *Hoffman et al.*, and further in view of *Simon et al.*, due to the missing element, it necessarily follows that Claims 9, 10, 13 and 14 are also non-obvious in view of *Hoffman et al.*, and further in view of *Simon et al.*, due to their dependency from Claim 8. Accordingly, withdrawal of the rejections of Claims 1-7, 9, 10, 13 and 14 under 35 U.S.C. § 103(a) is appropriate and respectfully requested.

The Rejection of Claim 15 Under 35 U.S.C. § 103(a)

Claim 15 was rejected under 35 U.S.C. § 103(a) as being unpatentable over *Hoffman et al.* in view of *Simon et al.*, and further in view of United States Patent No. 6,608,295 (*Engelhardt et al.*). Applicants respectfully traverse this rejection and request reconsideration for the following reasons.

For the reasons outlined above in connection with the rejection of Claims 1-7, 9, 10, 13 and 14 under 35 U.S.C. § 103(a), Applicants also maintain that the rejection of Claim 15 under 35 U.S.C. § 103(a), supported by *Hoffman et al.*, cannot stand for the same reasons set-forth above relative to common ownership of each.

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Assuming *arguendo* that *Hoffman et al.* could be used to support a rejection of Claim 15 under 35 U.S.C. § 103(a), which it cannot, as described above, *Simon et al.* do not teach a displaceable deflection unit. Similarly, *Engelhardt et al.* do not teach a displaceable deflection unit. As the cited references fail to disclose a displaceable deflection unit, it follows that Claim 15, which includes a displaceable deflection unit due it dependency from Claim 8, is non-obvious in view of *Hoffman et al.*, *Simon et al.* and *Engelhardt et al.*. Thus, withdrawal of the rejection of Claim 15 is appropriate and courteously requested.

### **Conclusion**

For all the reasons outlined above, Applicants respectfully submit that the claims are patentable over the cited references and in condition for allowance, which action is courteously requested.

Respectfully submitted,



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